



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,698	01/22/2001	Alan W. H. Grant	48971-023 (AWGK-001)	1729
53961	7590	03/22/2006		
FALKOWSKI PLLC			EXAMINER	
P.O. BOX 650			THAI, CANG G	
NOVI, MI 48376-0650			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/766,698	GRANT, ALAN W. H.
	Examiner	Art Unit
	Cang G. Thai	3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 2/15/2006.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3,4 and 9-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3,4 and 9-21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1, 3-4 and 9-21 are rejected under 35 U.S.C. 101 because for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. "Usefulness" may be evidenced by, but not limited to, a specific utility of the claimed invention. "Concreteness" may be evidenced by, but not limited to, repeatability and/or implementation without undue experimentation. "Tangibility" may be evidenced by, but not limited to, a real or actual effect.

In the present case, identifying a number of exchange elements which are offered to the constituent population by the associating a cost to the entity with each of exchange elements, identifying a number of behaviors of constituent population, identifying a value exchange gap with at least one constituent by receiving an incremental valuation from at least one constituent that relates to at least one behavior and receiving feedback from at least one constituent that reduces the value exchange gap that for the constituent providing the received feedback by adding an exchange element between at least one constituent and the entity are subjective. Thus, because the identifying a number of exchange elements, behaviors and others are subjective, for

a single situation, there could be different results based on the subjective determination of the user. Therefore, the applicant's invention is not capable of providing concrete results as required by 35 U.S.C. 101 since it would be difficult for a person to repeat the analysis and determination of another based on the subjective subject matter without undue experimentation.

Furthermore, the claimed invention is not supported by either a credible asserted utility or a well-established utility. It is unclear how the specific utility of the claimed invention as described in the disclosure of this application would be useful or tangible to one in the industry. It is unclear how the identifying a number of exchange elements which are offered to the constituent population by the associating a cost to the entity with each of exchange elements, identifying a number of behaviors of constituent population, identifying a value exchange gap with at least one constituent by receiving an incremental valuation from at least one constituent that relates to at least one behavior and receiving feedback from at least one constituent that reduces the value exchange gap that for the constituent providing the received feedback by adding an exchange element between at least one constituent and the entity, i.e., what does the identifying a number of exchange elements which are offered to the constituent population means to a person in the industry, identifying a number of behaviors of constituent population, and others, especially in view of the fact that any comparison is made by comparing the exchange elements and number of behaviors with a predetermined threshold value which is not an industry standard value or a mathematically derived standard but rather an exchange element chosen by the

constituent population. For example, an academic test score of 95 is considered an A unless specifically defined otherwise. What does identifying a number of exchange elements which are offered to the constituent population means to a person in the industry, identifying a number of behaviors of constituent population, and others is derived by this invention mean and to whom does it have a meaning. Is there a threshold value that has a real world meaning?

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 4 & 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear on the storing mindset data? Is it a human that performs the input?

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

I. U.S. Patent:

- 1) U.S. Patent No. 6,092,047 (HYMAN ET AL) is cited to teach apparatus and method of composing a plan of flexible benefits,
- 2) U.S. Patent No. 5,802,500 (RYAN ET AL) is cited to teach system and method for computing a financial projection of a prefunding program for other postretirement employee benefits under FASB statement 106,

- 3) U.S. Patent No. 6,757,660 (CANADA ET AL) is cited to teach method for analyzing information to provide an objective assessment of a predefined subject,
- 4) U.S. Patent No. 6,944,597 (CALLEN ET AL) is cited to teach providing termination benefits for employees, and
- 5) U.S. Patent No. 6,735,569 (WIZIG) is cited to teach method and system for providing a user-selected healthcare services package and healthcare services panel customized based on the user's selections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cang (James) G. Thai whose telephone number is (571) 272-6499. The examiner can normally be reached on 6:30 AM - 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CGT  
03/14/2006



JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600